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IN THE

Supreme Court of the United States

OCTOBER TERM, 1949.

No. 543

JIFFY LUBRICATOR COMPANY, INC.,
Petitioner,

vs.

THE ALEMITE COMPANY,
Respondent.

RESPONDENT'S REPLY TO PETITION FOR REHEARING.

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I.

The Petition for Rehearing Violates Rule 33(2) of This Court and Should Be Denied.

Rule 33(2) of the rules of this Court provides that any petition for rehearing of an order denying a petition for a writ of certiorari must be limited to: (1) "grounds which are confined to intervening circumstances of substantial or controlling effect," or (2) "to other substantial grounds available to petitioner although not previously presented."

Counsel's apologetic certificate in support of the petition for rehearing concedes that the alleged new grounds "not presented" in the petition for writ of certiorari were not

"• • • previously presented *except to the extent* covered by petitioner's Reply Brief filed March 8, 1950." (Emphasis ours.)

The petition for rehearing filed herein does not include any grounds within either category specified in the foregoing rule and for this reason alone the petition for rehearing should be denied.

Ground 1 asserted in the petition for rehearing presents the argument that Gullborg patent No. 1,307,734 (not here in suit, which issued in 1919 and expired almost fourteen years ago) was, during the time it was in force, clothed with an allegedly false cloak of commercial success. It is not shown in the present petition how this allegation, even if true, can impart validity to the Johnson patent here in suit which the Court below stated was clearly invalid as lacking invention over the prior art.

Ground 1 of the petition for rehearing and the allegations with respect thereto are admittedly contained in the reply brief filed by petitioner in support of its petition for certiorari and, therefore, under Rule 33(2) of this Court, cannot provide the basis for a petition for rehearing.

Ground 2 of the petition for rehearing relates to alleged conflicts among the Courts of Appeal as to the interpretation to be placed upon the opinion of this Court in *Cuno Engineering Corp.* v. *Automatic Devices Corp.*, 314 U. S. 84. This argument has heretofore been urged extensively in the petition for certiorari (Question 11, page 37), the brief in support thereof (pages 29 and 30), and in petitioner's reply brief (pages 20 and 21).

In the previous arguments petitioner urged the opinion of the Seventh Circuit Court of Appeals in *Falkenberg* v. *Bernard Edward Co.*, 175 F. 2d 427, "and that of the other circuits whose decisions are cited therein." The

decisions cited therein are *Browne & Sharpe Mfg. Co.* v. *Kar Engineering Co.*, 154 F. 2d 48, and *Trabon Engineering Co.* v. *Dirkes*, 136 F. 2d 24. In its petition for rehearing in support of ground 2, petitioner asserts these same cases and in addition the recent case of *Trico Products Corp.* v. *Delman Corp.*, ... F. 2d..... (84 U. S. P. Q. 416), in which the Eighth Circuit Court of Appeals affirmed the judgment of a trial Court holding two patents invalid. In the *Trico* case the Court merely restated the rule with respect to invention which it set forth in its opinion in the instant case. The decision in the *Trico* case adds nothing to the arguments heretofore presented by petitioner relative to these cases and, therefore, the whole of ground 2 of the petition for rehearing, having been extensively presented to this Court, is not properly within the petition for rehearing.

It is apparent therefore that since both of the grounds of the petition for rehearing have been presented to this Court in the original petition and briefs in support thereof, the present petition for rehearing is not a proper petition under Rule 33(2) and should be denied.

II.

The Petition for Rehearing Is, in Substance, Without Merit.

Petitioner, in its reargument of the matters heretofore brought before this Court in its extensive petition and briefs, again studiously avoids the clear-cut issue determined by the Court below.

Petitioner brought suit for infringement of Johnson patent No. 2,040,177 which issued in 1936. The Court of Appeals below stated, relative to the Johnson patent:

> "• • • What the Johnsons did—as we see it—was to substitute for the bayonet type of connecting means

> of Gullborg, which was old, a chuck type of connecting means, also old * * *. Substituting an old and well known form of coupler for another form of coupler equally well known, did not, in our opinion, require invention, but merely mechanical skill. * * * To use means old in the art to clamp a grease nozzle to a grease fitting, so as to form a tight connection, does not involve patentable invention. * * * it is our opinion that the evidence, viewed in the aspect most favorable to the plaintiff, does not sustain the conclusion that the Johnsons' contribution to the art of lubrication rose to the level of patentable invention." (176 F. 2d 444, 448, 449.)

In the original petition and briefs, petitioner carefully refrained from attempting to point out wherein the Johnson patent contributed anything new to the field of lubricating couplers and failed completely to show wherein the structure of the Johnson patent constitutes an invention over the prior art shown by the record in this case. The petition for rehearing again avoids the only issue determined by the Court of Appeals below. There being no patentable invention in the structure of the Johnson patent, the opinion of the Court below must stand.

In a last ditch effort to persuade this Court to grant certiorari petitioner has attempted to inject into this case a question of illegal patent practice and monopoly. The alleged facts upon which petitioner now argues in support of ground 1 and in its reply brief on the petition for certiorari are outside of the record in this case and have no bearing on the validity of the Johnson patent, the only issue determined by the Court below.

The Gullborg patent of which petitioner complains was issued in 1919 and the last litigation in which it was involved was the decision by this Court in 1936, a few months before the patent expired. The disclosure of the Gullborg patent constitutes art long prior to the Johnson patent

here in suit. Nothing offered by petitioner can attribute any novelty or vitality to the Johnson patent which the Court of Appeals has held clearly invalid.

It is of course impossible—and petitioner does not attempt—to show how the reckless and unfounded charges of illegal practices under the Gullborg patent before 1936 affect the instant suit brought by Jiffy Lubricator Company for infringement of the Johnson patent. The *Hazel Atlas* case and the *Precision Instrument* case urged in support of ground 1 both relate to situations in which illegality relating to the patent in suit was established as a defense. These authorities are therefore not relevant to the present case where plaintiff attempts to employ alleged illegal patent practices ascribed to the defendant as supporting plaintiff's case on a clearly invalid patent.

The case of *Stewart-Warner* v. *Staley,* 42 F. Supp. 140 (relied on in petitioner's Brief in Support of Petition for Writ of Certiorari, p. 15, and Petitioner's Reply Brief, p. 13), is likewise not relevant. Alleged violation of the anti-trust laws was the subject matter of that case. Petitioner errs in stating that the Court there concluded that the anti-trust laws had been violated as the opinion is concerned solely with a motion to strike the complaint.

Ground 2 of the petition for rehearing asserts that the Eighth Circuit Court of Appeals in patent cases has established a standard of invention higher than, and in conflict with, various other Courts of Appeal. Petitioner does not suggest that the standard of invention applied by the Eighth Circuit Court of Appeals is not in conformity with the tests of invention prescribed by this Court. A study of the opinions of the Eighth Circuit Court of Appeals relied upon by petitioner clearly indicates that the Court is applying a standard of invention not in conflict with other Courts of Appeal.

All of the opinions cited by petitioner in ground 2 recognize that there must exist ingenuity beyond the skill of the ordinary mechanic before a Court is warranted in holding that there is a valid patentable invention. Relative to the structure of the Johnson patent, the Court of Appeals below stated:

> "* * * Substituting an old and well known form of a coupler for another form of coupler equally well known, did not, in our opinion, require invention, but merely mechanical skill. * * *
>
> "* * * To use means old in the art to clamp a grease nozzle to a grease fitting so as to form a tight connection, does not involve patentable invention. * * *" (176 F. 2d 444, 448).

Petitioner has failed to show wherein the structure of the Johnson patent distinguishes over the prior art patents in the record. The conclusion that the Johnson patent is clearly invalid for lack of invention is in harmony with the standards of invention set forth in all of the opinions of the various circuits cited by petitioner.

Petitioner's surmise that, upon a denial of its petition for rehearing, the lubricating industry faces dire prospects of continued patent litigation, is lacking in substance. There certainly has been much litigation involving lubricating apparatus including decisions of many Courts of Appeal and at least two decisions of this Court (303 U. S. 545; 298 U. S. 415 and see footnote 3, 298 U. S. 417) setting forth the standards of invention applicable to patents for lubricating apparatus.

Petitioner has been primarily responsible for the existence of such patent litigation since 1938 and such litigation was instituted in the face of these earlier clear-cut opinions reviewing extensive art in this crowded field and establishing the minimum requirements of novelty sufficient to sustain the validity of patents on lubricating ap-

paratus. This litigation has merely confirmed the standards heretofore set.

Respectfully submitted,

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